

REMARKS

The Examiners, Messrs. Patel and Canning, are thanked for the courtesy extended applicants representatives during the interview conducted February 23, 2006, at which time the inapplicability of the cited art to the claimed invention.

As indicated in the Interview Summary, agreement was reached with respect to some claims noting that the Examiner indicates "claim 2 was discussed and the Examiner concedes that the adhesive layer is not disposed by Ando et al. ... The structural limitation of claim 14 was discussed with regard to a recess in the metal sheet, the Examiner concedes with the applicant. The Examiner agrees with the applicant in regards to claims 2, 14 and 19 ...". (emphasis added).

In light of the discussion and the Interview Summary, submitted herewith is an amendment in which independent claim 1 has been canceled, and claim 2, which the Examiner concedes is not disclosed by the cited art, and in particular, the combination of Mitsutake et al in combination with Ando et al, has been written in independent form, noting that the rewriting of claim 2 in independent form does not raise any new issues requiring further search and/or consideration. Furthermore, claims 4 - 6 which depend directly or indirectly from claim 2 have been retained without amendment while dependent claims 3 and 7 - 14 which previously depended upon claim 1 have been amended to depend from independent claim 2, and hereagain, such amendments do not raise any new issues requiring further search and/or consideration. In this regard, it is recognized that the Examiner has indicated that the Examiner has recognized that the features of claim 14 are not disclosed or taught in the cited art. Since claim 19 also recites the feature of recesses for holding the spacers being provided in the electrically conductive sheet, in a manner similar to claim 14 and the Examiner has recognized that such features are not disclosed or

taught in the cited art, claim 19 has been retained without amendment. As to independent claims 15 and 16, by the present amendment, such independent claims have been amended to further recite the feature of claim 2 therein and applicants submit that such amendment also does not raise new issues requiring further search and/or consideration. Furthermore, by the present amendment, claim 20 which depended from claim 19 has been canceled and new dependent claims 21 and 22, dependent from claim 19, have been added, wherein claim 20 recites the limitation that the electrically conductive sheet is a metal sheet, as previously recited in claim 1 and claim 22 recites the limitation that the electrically conductive sheet is a black sheet, as recited in claim 16. Thus, the addition of such claims do not raise new issues requiring further search and/or consideration noting in view of the cancellation of claims 1 and 20, and the addition of new claims 21 and 22, the total number of claims presented for examination remains the same.

As to the rejection of claims 1, 3, 8 - 11, 13 and 15 - 18 under 35 USC 103(a) as being unpatentable over Mitsutake et al (US 5,760,538), in view of Curtin et al (US 5,477,105); the rejection of claims 14 and 19 under 35 USC 103(a) as being unpatentable over Mitsutake et al (US 5,760,538) in view of Curtin et al (US 5,477,105) and further in view of Spindt (US 5,990,614); and the rejection of claims 2 and 4 - 6 under 35 USC 103(a) as being unpatentable over Mitsutake et al (US 5,760,538) in view of Ando et al (US 2002/0079829 A1); such rejections are considered to be obviated by the cancellation of claim 1, the rewriting of claim 2 in independent form, and the amendments of claim 15 and 16 to incorporate features of claim 2 therein together with the other amendments as presented, noting that the rejections are traversed insofar as they are applicable to the present claims, and reconsideration and withdrawal of the rejections are respectfully requested.

At the outset, it is noted that the Office Action of November 30, 2005, may be considered to be incomplete since there is no statement of a ground of rejection under 35 USC 103 with respect to claim 20. However, as noted above, since independent claim 19 is conceded by the Examiner as to not being disclosed or taught in the cited art, by the present amendment, claim 20 has been canceled and new dependent claims 21 and 22 presented.

As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature

which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Looking to independent claim 2, applicants note that such claim recites the limitation of previous dependent claim 2 of "said display substrate further includes an adherent layer for fixing said metal sheet to said light-transmissive substrate". (emphasis added).

Referring to Figs. 1 and 2 of the drawings of this application, the light-transmissive substrate is indicated by reference numeral 110, the metal sheet by reference numeral 120, and the adherent layer for affixing the metal sheet to the light-transmissive substrate 110 by reference numeral 112, the adherent layer being disposed between the metal sheet 120 and the light-transmissive substrate 110, so as to achieve the fixing in the manner recited. As illustrated in Figs. 1 and 2, phosphor 111 is provided in the holes perforated in the metal sheet 120 and a metal back 114 is provided in the manner indicated. Thus, the metal back 114 is different from the metal sheet 120 and, as apparent, the metal back 114 is not adhered to the light-transmissive substrate 110, but rather, an adherent layer 112 is utilized for affixing the metal sheet 120 to the light-transmissive substrate 110.

In rejecting claim 2 and its dependent claims on the combination of Mitsutake et al and Ando et al in the manner set forth in paragraph 16 of the office action, the

Examiner indicates in paragraph 17, Mitsutake fail to disclose that the display substrate further includes an adherent layer for affixing the metal sheet to the light-transmissive substrate." (emphasis added). In the first and second paragraphs at page 10 of the office action, the Examiner states:

Regarding claims 13 and 17, Mitsutake et al. disclose a flat panel display device according to claims 1 and 16. Mitsutake et al. further disclose that wherein the metal sheet is provided on a side thereof facing toward the rear substrate with a metal back, and that the black sheet is electrically conductive (see Fig. 25, item 19; column 29, line 40 - 54).

Regarding claim 18, Mitsutake et al. disclose a flat panel display device according to claim 16, wherein the black sheet is made of a metal (see Fig. 2, item 19; see Fig. 4B, item 21b; column 8, lines 20-24; column 8, lines 30-44).

Irrespective of the Examiner's contentions, Ando et al may be considered to disclose a metal sheet 1018 a light-transmissive substrate 1017 and a metal back 1019 corresponding respectively to the corresponding structure 17, 18, 19 of Fig. 1 of Mitsutake et al, noting the common inventors. Ando et al discloses a bonding agent 1041 for bonding a low resistance layer 21 of a spacer 1020 to the metal back 1019. Thus, it is readily apparent that the metal back 1019 is different from the metal sheet 1018 and there is no disclosure or teaching in Mitsutake et al or Ando et al of an adherent layer for affixing the metal sheet to the light-transmissive substrate and it cannot be considered obvious in the sense of 35 USC 103 to provide the limitation regarding to the adherent layer in claim 2 other than by a hindsight reconstruction attempt and utilizing what applicant has taught against the teacher, which is not proper. See In re Fine, supra and In re Lee, supra. Thus, applicants submit that as conceded by the Examiner, the limitation regarding to the adherent layer in claim 2 are not disclosed or taught in the cited art, and applicants submit that claim 2 and the

dependent claims should be considered allowable thereover in the sense of 35 USC 103.

With regard to the dependent claims 4 - 6, which were originally dependent upon claim 2, applicants note that it is apparent that Ando et al and Mitsutake et al do not disclose the limitation regarding to the adherent layer in claim 2 and therewith the dependent claims. For example, whether or not Ando et al may be considered to disclose a bonding agent 1041 which may be made of glass, Ando et al does not disclose an adherent layer as claimed which is made chiefly of ceramics or alumina, that the adherent layer is a layer having its light transmission limited to a specified value, and that the coefficients of thermal expansion of the metal sheet, the light-transmissive substrate and the adherent layer are approximately equal to one another. Whether or not such a construction can be made, there is no disclosure or teaching in the cited art of such features in the sense of 35 USC 103 and "obvious to try" is not the standard of 35 USC 103. Additionally, the other dependent claims which have been amended to depend from claim 2 recite additional features. Thus, applicants submit that claim 2 and the dependent claims, patentably distinguish over the cited art and should be considered allowable thereover.

As noted above, independent claims 15 and 16 have been amended to also recite the limitation of previous dependent claim 2 therein, and such claims together with their dependent claims patentably distinguish over the cited art for the reasons given above and should be considered allowable at this time.

As to claims 14 and 19, as set forth in the rejection at paragraph 12 at page 6 of the office action, the Examiner in paragraph 13 recognizes that "Mitsutake et al fail to teach that the metal sheet is provided with recesses for holding the spacers." Applicants note that the recesses in the metal sheet 120 for holding the spacers 30

are clearly illustrated in Fig. 1 of the drawings of this application and disclosed in the specification, noting that the metal back 114 has conforming recesses therein. The Examiner, however, contends that "Spindt discloses a flat panel display device, which provides the metal sheet with recesses capable of holding the spacers (see Fig. 3, items 16 and 74); column 10, lines 55 - 56; column 11, lines 26 - 31)." (emphasis added). Irrespective of the Examiner's contentions, assuming arguendo that element 24 in Fig. 3 of Spindt is a light-transmissive substrate, element 72 is a sheet in the form of a black matrix, which would correspond to the metal sheet 18 of Mitsutake et al and the dark ridges or sheet 314 of Curtin et al having holes in which phosphor 70 is provided and further, a metal back 74 is provided, it is readily apparent that while recesses may be provided in the metal back 74 of Spindt, for holding the spacers 16, there is no disclosure or teaching in Spindt or the other cited art that the element 72 of Spindt is provided with recesses capable of holding the spacers, in the manner illustrated in Fig. 1 of the drawings of this application. Thus, irrespective of the position set forth by the Examiner in the office action, the Examiner has conceded at the interview as recognized in the interview summary that such limitations are not disclosed or taught in the cited art. Thus, claims 14 and 19 and the dependent claims thereof patentably distinguish over the combination of references indicated by the Examiner in the sense of 35 USC 103 and all claims should be considered allowable thereover.

As noted above, claim 14 has been amended to depend from claim 2 while new dependent claims 21 and 22 have been added which depend from claim 19 and such claims should be considered allowable at this time.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 520.43191X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

A handwritten signature in cursive script, appearing to read "Melvin Kraus", is written over a horizontal line.

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